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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,450

Applicant(s)

SUGIYAMA ET AL.

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11/1/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on November 1, 2004 has been considered but is ineffective to overcome the Henson (6,167,383), Burke (5,848,399), and Storey (5,774,870) references. The amendment amended Claims 1, 4, 6-10, 14, 21, and 23-33. No claims were canceled or added; thus, the currently pending claims considered below remain Claim 1-33.

### ***Claim Rejections - 35 USC § 112***

2. The amendment filed on November 1, 2004 corrected the deficiencies noted in the rejections of Claims 4, 8, and 14 noted in paragraph 2 and of Claims 1-33 in paragraph 3 of the June 30, 2004 Office Action. Therefore, the Examiner hereby withdraws those rejections.

### ***Claim Rejections - 35 USC § 101***

3. The amendment filed November 1, 2004 amended Claims 28, 29, 30, and others to add technological matter to overcome the rejection in paragraph 5 of the June 30, 2004 Office Action. Therefore the Examiner hereby withdraws that rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 and 16-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (6,167,383) in view of Burke (5,848,399).

Claims 1, 2, and 24-33: Henson discloses a system, apparatus, method and computer program for distributing information, comprising

- a. Storing, selecting, and retrieving purchase information (shopping cart) pertaining to a purchase by a user (col 3, lines 4-11);
- b. Receiving and displaying the selected purchase information at a user terminal (col 4, line 56 – col 5, line 19); and
- c. Storing a use log of the user's interaction with the selected purchase information, such as selecting a settlement program (payment method)(Figure 10, item 124; col 3, lines 26-29; col 4, line 56 – col 5, line 19; and col 11, line 32 – col 12, line 9).

While Henson discloses that the information displayed to the user could include "customer-specific merchandising messaging 100 as to up-sell and cross-sell opportunities" (col 9, lines 41-44), it is not explicitly disclosed that the displayed message is a coupon, such as in Claim 2. However, Burke discloses a similar system, apparatus, method, and computer program for distributing information using purchase information which also discloses the promotional message including "games or

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coupons" (Figure 1, item 57 and col 12, lines 16-20) and that "Advertising and promotion data 57 may also be added to the picture 60 generated by the video display generator 58. Such data 57 may include coupons, special discounts, indications that an item is new, and other promotional information" (col 5, lines 28-31). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include coupons as one type of merchandising message in Henson. One would have been motivated to include coupons in order to better motivate the user to purchase the product or service, which is the implicit aim of all such promotions, advertisements, and coupons.

While neither of the references explicitly disclose the newly added feature that a wireless communication network is being used to transmit the information and data between the various nodes, Official Notice is taken that wireless connections to various communication networks, such as telephone, television, and computer networks, are old and well known. Wireless and cellular telephones, personal data assistants (PDA's), and laptop and desktop computers all were well known and widely used examples of wireless communication system within our society at the time of the present invention and have been developed and used to allow the users more mobility. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to connect the terminals in Henson and Burke (the information distributing, buyer, and seller terminals) using known wireless technology. One would have been motivated to use wireless technology to connect the nodes in order to allow the user to purchase items from the seller at whatever location the user may be in at the time, i.e.

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increase mobility. The Examiner further notes that whether the communication network is a wired or a wireless does not affect the steps of the claimed methods. The information distribution apparatus, the terminal apparatus, and the sales apparatus in Claim 1 would perform the same steps whether their "communication units" were coupled to a wired or wireless connection. Therefore, little, if any, patentable weight is given to the type of connection through which the information and data is passed.

Claim 3: Henson and Burke disclose a system for distributing information as in Claim 2 above, and Burke further discloses displaying a coupon to the user. While it is not explicitly disclosed what information is being included on the coupon, the claimed information (identifier, commodity name, privilege (i.e. discount), store name, and classification name) are common information usually found on coupons. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include at least the claimed information on the coupon. One would have been motivated to include such information in order to more easily identify and track the usage of the coupon and to better inform the user of the terms of the coupon (i.e. where, when, and for how much the coupon could be used).

Claim 4: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Burke further discloses displaying coupons usable at stores local to the user's present location(col 6, lines 50-61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display information, such as a coupon, to the user based on the user's present location. One

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would have been motivated to use the user's present location when selecting the information to be displayed in order to present information more pertinent to the user.

Claim 5: Henson and Burke disclose a system for distributing information as in Claim 1, but do not disclose the specific information being stored in the use log. The Examiner notes that the claimed information: purchase identifier, user identifier, store identifier, and use date, are the normal type of information stored when tracking usage of coupons and it would have been obvious to one having ordinary skill in the art at the time the invention was made to track and store at least these types of information in Henson. One would have been motivated to store the usage data to include the identifiers of all parties involved and the date of usage in order to allow the coupon issuer to make a more meaningful analysis of their promotional program as is common in the marketing arts.

Claim 6: Henson and Burke disclose a system for distributing information as in Claim 1 above, and both references further disclose transmitting and storing purchase information (Henson, col 9, lines 26-55)(Burke, col 6, lines 50-61).

Claim 7: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Henson further discloses selecting the information based on matching criteria with the purchase information (col 9, lines 56-67).

Claim 8: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Burke further discloses transmitting the coupon information to the sales terminal (col 6, lines 50-61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to not only display the coupon

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information to the user, but to also transmit the coupon information to the merchant (sales apparatus) for whom the coupon pertains (is redeemable at). One would have been motivated to send this information to the merchant in order for the merchant to be able to verify that the coupon presented by the user is an authorized (authentic) coupon, i.e. cross-checking).

Claims 16-19: Henson and Burke disclose a system for distributing information as in Claim 1 above. While neither reference explicitly discloses that the purchase information pertains to a travel itinerary used to purchase transportation tickets or to an electronic trading system used to purchase shares of stock, the Examiner notes that the type of product or service being purchased by the user does not affect the claimed steps of using the purchase information to display messages to the user and is, therefore, given little if any patentable weight. It would have been obvious to one having ordinary skill in the art that the system and method described in Henson and claimed in the present invention could be used with purchase information from any type of product or service transaction. One would have been motivated to extend the use to travel and stock purchases in order to increase the utility of the system.

While neither reference explicitly discloses that the user is using a "vending machine", Henson discloses that the user may "access the online store 10 using any suitable computer equipment 40, via the Internet 42" (col 5, line 66 – col 6, line 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the user in Henson to access the system via a vending machine, a kiosk, or any other computing device that has access to the Internet. One



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would have been motivated to allow the user to connect to the system via a vending machine or kiosk in order to allow use of the system when the user is not at home, e.g. in a mall or on vacation.

Claims 9 and 20: Henson and Burke disclose a system for distributing information as in Claims 1 and 19 above, and Henson further discloses issuing a proof of purchase (e.g. a receipt) via at least the Internet (col 9, lines 40-44).

Claim 10: Henson and Burke disclose a system for distributing information as in Claim 9 above. While Henson discloses providing “up-sell and cross-sell opportunities” (recommendations) as part of the merchandising messages presented to the customer (col 9, lines 41-44), it is not explicitly disclosed that the recommendation information includes a purchase information identifier, an object store name, and a classification name. However, it would have been obvious to one having ordinary skill in the art of speaking that any information to include the claimed identifier, store name, and classification, could be included in the recommendation communicated to the user in Henson. One would have been motivated to communicate this type of information to the user in order to inform the user about where a particular purchase was made and for what type of product or service.

Claims 21 and 22: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Henson further discloses receiving user feedback (selections) and analyzing such feedback to select information to provide to the user, e.g. recommendations for additional equipment or on the compatibility of the selected equipment. (col 7, lines 29-38).

Claim 23: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Burke discloses tracking the use of the system to include the merchandising information (e.g. coupons) displayed to the user. While neither reference explicitly discloses that the coupon issuer (advertiser) is charged for the distribution of their information to the user, Official Notice is taken that it is old and well known throughout the marketing arts for advertisers to pay a third party, such as the system in Henson, to display their promotional information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to charge the store (advertiser) for displaying the information to the user in Henson. One would have been motivated to charge the store in order to maintain financial viability of the system.

6. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (6,167,383) in view of Burke (5,848,399) as applied to claim 1 above, and further in view of Storey (5,774,870).

Claim 11: Henson and Burke disclose a system for distributing information as in Claim 1 above, and Burke further discloses that the information could be promotional information pertaining to games or coupons (col 12, lines 16-20). However, neither reference explicitly discloses that the user will be awarded prize points based on the purchase information, i.e. that is system is part of a merchant's frequent buyer program. However, Storey discloses a similar system for distributing information in which the user may earn prize points for purchases (col 1, line 57 – col 2, line 27 and col 8, line 3 – col

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10, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to award points to users in Henson. One would have been motivated to award points to the user in order to entice the use to increase participation/utilization of the system.

Claim 12: Henson, Burke, and Storey disclose a system for distributing information to include awarding prize points to the user as in Claim 11 above, and Storey further discloses the prize information containing at least the commodity name, a number of points, a number of necessary points, and a classification name (col 1, line 57 – col 2, line 27 and col 8, line 3 – col 10, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such data in the prize information in Henson. One would have been motivated to include this data in order to allow the merchant to better track the promotional program and the number of points outstanding by each user.

Claim 13: Henson, Burke, and Storey disclose a system for distributing information to include awarding prize points as in Claim 12 above, and Storey further discloses awarding the prize to the user if the number of points exceeds the number of points necessary for the prize (col 1, line 57 – col 2, line 27 and col 8, line 3 – col 10, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to award the prize to the user in Henson once the required number of points had been earned. One would have been motivated to award the prize in this manner in order to entice the user to earn more points.

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Claim 14: Henson, Burke, and Storey disclose a system for distributing information to include awarding prize points to the user as in Claim 1 (and 14) above, and Storey further discloses registering the user (setting up an award point account for the user) and tracking the frequency of use of the system by the user, which is then used to award points (col 1, line 57 – col 2, line 27 and col 5, lines 36-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to register the user in Henson and to award points based on the frequency of access by the user. One would have been motivated to register the user in order to better track the users of the system. One would have been motivated to award points based on the usage of the system in order to entice the user to utilize the system more frequently.

Claim 15: Henson, Burke, and Storey disclose a system for distributing information to include awarding prize points as in Claim 14 above, and Storey further discloses updating the prize points database each time the user earns or redeems points (col 5, lines 36-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to update the user's points account. One would have been motivated to update the points account in order to enable the award system to function.

### ***Response to Arguments***

7. Applicant's arguments filed November 1, 2004 have been fully considered but they are not persuasive.

a. The Applicant argues that Henson does not disclose "a terminal apparatus that sends purchase information to a sales apparatus 'in response to an operation performed by the user when the user purchases the commodity or utilizes the service at the seller location', as claimed" (page 26). The Examiner notes that the user in Henson accesses the online store "using any suitable computer equipment" (i.e. a terminal) with a display, keyboard, and pointing device (col 5, line 66 – col 6, line 4). As per the Applicant's argument that the connection in Henson is not "wireless", the Examiner directs the Applicant's attention to the rejection of this newly claimed feature in reference to Claim 1 above.

b. The Applicant also argues that "Allowing customers to purchase products from home does not constitute sending purchase information to a sales apparatus ... when the user purchases the commodity or utilizes the service at the seller location" (page 27). The Examiner notes that it is inherent that in order to purchase products from an online seller as disclosed by Henson the customer must send the purchase information to the online sales apparatus. This information is not transmitted to the seller until the customer purchases the commodity or service.

c. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references pertain to remote purchasing of items and displaying promotional information, such as “up-sell and cross-sell opportunities” (Henson) or “coupons, special discounts, indications that an item is new, and other promotional information” (Burke). Since it is common that up-sells and cross-sells are oftentimes accompanied by some type of discount to further entice the customer to purchase the up-sell or cross-sell, it would have been obvious to include the types of promotions disclosed by Burke, i.e. coupons, special discounts, etc. The Applicant is reminded that obviousness is not based on whether or not that the invention disclosed by the two reference can be bodily fused together (i.e. all features in Reference A can be incorporated with all features in Reference B), but that the entirety of the two references would have suggested to one of ordinary skill in the art the combination of features within the two references to arrive at the claimed invention.

d. The Applicant argues that neither Henson nor Burke disclose a communication unit configured to send purchase information to a terminal apparatus and receive use log information reflecting a result of a use of the selected purchase information from the terminal apparatus (page 29). The Examiner notes that Henson discloses the user receiving purchase information (i.e. a catalog or list of products) from the online sales system, selecting one or more items to purchase, and transmitting this information to the sales system. Thus, the sales system is using a communication unit to transmit the purchase information to the user’s terminal, the user is using the

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information (i.e. selecting one or more items), and data indicating the user's selection (i.e. log information) is transmitted back to the sales system.

e. The Applicant argues that Storey does not disclose a terminal apparatus (page 33). However, the Examiner has shown above that Henson already shows this feature, thus whether or not Storey also discloses the terminal apparatus is mute.

f. As to the Applicant's argument in reference to the combination of Storey with the other two references, the Examiner directs the Applicant's attention to the response to the similar argument about the combination of Henson and Burke above. Storey is also directed towards conducting remote sales and further discloses steps to implement the well known promotional tool of awarding "points" to buyers. One of ordinary skill in the art would have realized the advantages of incorporating such a promotional tool into the online buying system of Henson and Burke.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

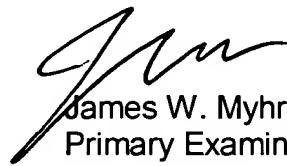
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

  
JWM

December 29, 2004

  
James W. Myhre  
Primary Examiner  
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